

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 1-10 are pending in this application.

The outstanding Office Action includes a rejection of Claim 1-10 under 35 U.S.C. § 103(a) as being unpatentable over Takashi (JP 58-122822) in view of Parmann (U.S. Patent No. 3,929,958).

Before considering the rejection made under 35 U.S.C. § 103(a) based upon Takashi and Parmann, it is believed that a brief review of the subject matter of base Claim 1 would again be helpful. In this regard, this claimed subject matter is directed to a process for the bonding a plastics pipe to another plastics part by means of ultrasound welding that uses sound waves which act longitudinally with respect to the pipe axis, while the arrangement of the areas to be welded is substantially parallel to the pipe axis. This ultrasound welding is combined with the forced insertion of the other plastics part into the plastics pipe in such a way that the plastics pipe is widened while there is at least some overlap between the exposure to sound and the forced insertion. Note the last clause of Claim 1 requiring “forcing insertion of the coupling end portion into the plastics pipe so that the coupling end portion is inserted inside of and widens the plastics pipe during at least part of the time that the sound waves are being provided during the ultrasonic welding step.”

Turning to the rejection of Claims 1-10 under 35 U.S.C. § 103(a) as being unpatentable over Takashi in view of Parmann, it is first noted that this rejection is improper because the PTO has violated its own guidelines of MPEP § 706.02II. as to “RELIANCE UPON . . . FOREIGN LANGUAGE DOCUMENTS IN SUPPORT OF A REJECTION.”

In this regard, the reliance in the outstanding Action upon the actual Figures of Takashi (JP 58-122822) and not just the English Abstract is clear from the statement of the rejection at page 2 of the outstanding Action that reference the showings of the Takashi

Figures as to pipe 2, layer 1, jig 5, cap 3, and horn 7. However, MPEP § 706.02II. makes it clear that when a “document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection.” As further noted in this section, reliance on the Abstract alone “is generally inappropriate where both the abstract and the underlying document are prior art.” As further noted in this section, obtaining the translation is mandatory because the full text document can include “teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. 103, when the abstract alone appears to support the rejection,” which is not the case here as fully discussed below. Thus, given the importance of obtaining the translation, all examiners are cautioned that they may only make “a rejection in a non-final Office Action based in whole or in part on the abstract only without relying on the full text document.” As the outstanding and previous Actions have clearly violated this requirement in terms of relying on the untranslated document in both the previous improper non-final Office Action and the outstanding improper final Office Action, it is respectfully submitted that at least the finality of the outstanding Action should be withdrawn until the PTO supplies a translation in a proper Office Action treating the actual full text translation. As further noted in the final sentence of MPEP § 706.02II., whether this yet to be written and mailed Action “may be made final is governed by MPEP § 706.07(a).

Turning to the rejection as applied to independent Claim 1, it is clear that the outstanding rejection has failed to correctly analyze Takashi as to the insertion of pipe 2 with outer layer 1 into the inner periphery of the jig 5 as stated in the “CONSTITUTION.” This part of the English Abstract further notes that “the synthetic resin layer 1 of the pipe 2 is closely contacted to the periphery of the protruding part 6 which is arranged to the inner periphery of the jig 5 at its total periphery and the cap 3 made of synthetic resin is set at the

top of the pipe 2.” It is only then that “pressure is added from above to the cap 3, a supersonic vibration is given to the cap 3 by a supersonic fusion – bonding horn 7 and the cap 3 is fusion - bonded to the synthetic resin layer 1 of the pipe 2 and also the molten resin which exudes to the outer periphery of the synthetic resin layer 1 of the pipe 2 fills a vacant place 8 for a resin well.”

On the other hand, the teaching of Parmann is that a pipe end 18 is formed into a socket having an annular internal groove for the reception of a sealing element as noted at col. 6, lines 41-44 of Parmann. This socket formation involves the use of shape conferring elements including steel drift 1, annular separate mold element 2, and sleeve-shaped support member 3 that is axially displaceable on the steel drift member 1. See col. 6, lines 45-64. the outstanding Action incorrectly identifies 11 as part of a “a snugly telescoped configuration of the pipe sections” mentioned at col. 1, lines 6-13. However, as clearly set forth at col. 7, lines 8-11, the primary function of 11 is to ensure “an effective support for the mold element.” As further explained at col. 7, line 15 – col. 8, line 47, there is a two phase socket formation that widens the pipe end under heating and adds the annular internal groove with the mold element remaining in the socket to serve as a sealing element also mentioned at col. 5, lines 31-37 and lines 45-65.

However, the manner and means for providing the mold element remaining inside the socket of expanded pipe end 18 is completely different from the manner and means for providing an external cap 3 on the outside of a pipe 2 that has the synthetic resin layer 1 and which are both closely contacted to the periphery of the protruding part 6 of the jig 5 that has the well 8 to form the exterior resin – cap combination.

Contrary to established precedent, the outstanding Action never addresses these clear differences pointing to entirely different approaches in terms of the required explanation of why the artisan would even select these disparate references for combination, much less

present a convincing line of reasoning as to how the artisan could hope to modify Takashi based on the incompatible teachings of Parmann without destroying the basic thrust of the Takashi teachings. See *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) and the requirement there for the PTO to “explain the reasons one of ordinary skill would have been motivated to select the references and to combine them to render the claimed invention obvious.” As Takashi already has a snugly telescoped configuration as to the telescoped cap3 and pipe 2 secured by the melted resin formed by well 8, the reason offered at the top of page 3 as to providing a “snugly telescoped configuration” further makes no logical sense.

Moreover, as attempting to modify the exterior cap of Takashi with the interior seal in a widened socket portion of Parmann would require a complete redesign of Takashi and destroy the very essence of the exterior reinforced cap of Takashi, it is well settled that no *prima facie* case of obviousness has been set forth. See *In re Ratti*, 123 USPQ 349, 352 (CCPA 1959). Moreover, reference modifications that would render a reference unsatisfactory for its intended purpose are also not obvious. See *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

As Claims 2-10 all ultimately depend from Claim 1, the rejection of these claims that include all the subject matter of Claim 1 is also traversed for the above-noted reasons. In addition, the PTO reviewing court has recently explained the need for reliance on substantial evidence from the record in *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ 1769, 1775 (Fed. Cir. 2000) (“Because our review of the Board’s decision is confined to the factual record compiled by the Board ... the ‘substantial evidence’ standard is appropriate for our review of Board fact findings. See 5 U.S.C. §706(2)(E).”). The mere assertion of what is “well known and conventional in the art” clearly does not comply with the requirement in

Gartside that there be a “factual record.” Also note In re Zurko, 258 F.3d 1379, 1386, 59

USPQ2d 1693, 1698 (Fed. Cir. 2001) as follows:

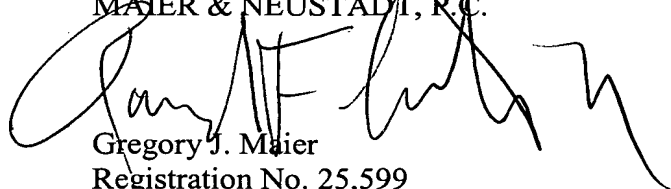
With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience — or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.

As the outstanding Action offers no concrete evidence that has been made of record to support the mere allegations of what is merely improperly asserted to be “well known and conventional in the art” as to the rejection of Claims 3, 4, 6-8, and 10, the rejection of these claims based upon this improper rationale is traversed for this reason as well.

As no further issues are believed to remain outstanding in the present application, it is believed that this application is clearly in condition for formal allowance and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Gregory J. Maier', is written over the printed name and firm information.

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